



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,481	08/29/2000	Curtis Wong	MS155614.1	8554

27195 7590 09/12/2003

AMIN & TUROCY, LLP
24TH FLOOR, NATIONAL CITY CENTER
1900 EAST NINTH STREET
CLEVELAND, OH 44114

EXAMINER

CORNWELL, BRIAN I

ART UNIT	PAPER NUMBER
----------	--------------

2614

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,481

Applicant(s)

WONG ET AL.

Examiner

Brian Cornwell

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 7 objected to because of the following informalities: "directly connected to the first computer" should read "directly connected to the second computer". Appropriate correction is required.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 24-25 have been renumbered 25-26.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4,7-9,13,16,18-19,20-23,25-26 rejected under 35 U.S.C. 102(e) as being anticipated by Hirata (6,374,406), cited by examiner.

As to claim 1, Hirata discloses a system for controlling an electronic device via a control

Art Unit: 2614

command signal contained in an electronic mail message. Hirata particularly discloses terminals that can be connected locally to a LAN or across the Internet (col.5 ln.31-35). Hirata also particularly discloses passing parameters within the email for recording a video program (col.5 ln.55-64) as claimed.

As to claim 2, the claimed operative association between the token and message component is met by the references disclosure of the email transmission to reserve a recording on the video deck (col.5 ln.14-17).

As to claim 3, the claimed "text email message" is met by the text within the email body in Figure 3.

As to claim 4, the claimed "elements identifying sufficient characteristics of the corresponding program" to record the program is met by the date, time and channel parameters within the email (col.5 ln.50-54).

As to claim 7, the claimed computers not having a direct connection is met by the indirect connection (across the Internet) of the terminals of Figure 3.

Claim 8 is met by that discussed above for claim 1.

As to claim 9, the claimed text component operatively associated to the message component is met by the control command text in the body of the email (fig.3).

Claim 13 is met by that discussed above for claim 4.

As to claim 16, Hirata discloses an email message (fig.3) and an operatively associated token (in this case, a control command signal) including program criteria (col.5 ln.51-54 & 60-64).

As to claim 18, the claimed email message addressed "to an address associated with a remote computer and sending the message" is met by the email of Figure 3 and the terminals 1-1 and 1-4 in Figure 1 (col.5 ln.14-17)

As to claim 19, the claimed program criteria containing sufficient characteristics to record the program is met by the time, date, and channel criteria within the control command string (col.5 ln.55-64).

Claim 20 is met by that discussed above for claim 1.

Claim 21 is met by that discussed above for claim 19.

Claim 22 is met by that discussed above for claim 1.

Claim 23 is met by that discussed above for claim 19.

Claim 25 is met by that discussed above for claim 18.

Claim 26 is met by that discussed above for claim 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-6,10-12,14-15,17,24 rejected under 35 U.S.C. 103(a) as being unpatentable over Hirata.

As to claim 5, Hirata discloses everything, as described above, except the "universal

Art Unit: 2614

program identifier". However the examiner gives official notice that it is notoriously well known in the art of video recording to use a universal program identifier for the purpose of identifying a program for recording. Therefore it is submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the universal program identifier to identify a program for recording for the purpose of minimizing the need to remember the time and channel of a particular program for recording.

As to claim 6, the claimed inclusion of "a plurality of program characteristics that identify different aspects of the corresponding program" is met by the program date, time and channel parameters passed in the email (col.5 ln.50-54).

As to claim 10, the reference discloses everything, as described above, except the inclusion of the token in an attachment to the email. However the examiner gives official notice that it is notoriously well known in the art of electronic mail to use an attachment for the purpose of transporting executable commands. Therefore it is submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an attachment to transport the control command string for the purpose of separating executables from the text portion of messages.

As to claim 11, the reference discloses discrete computer terminals and addressing the message to the client (fig.3) as claimed. As to the client receiving the email from a server, the client/server relationship is inherent within the email protocols used over the Internet.

As to claim 12, the reference particularly discloses the use of a text email message (fig.3).

Claim 14 is met by that discussed above for claim 5.

Art Unit: 2614

As to claim 15, the claimed "plurality of program characteristics that identify different aspects of the corresponding program" is met by the date, time and channel parameters within the email (col.5 ln.50-54).

Claim 17 is met by that discussed above for claim 10.

Claim 24 is met by that discussed above for claim 10.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Budge et al (6,564,248) discloses a communications interface for playing and recording video programs that are transported via email and enclosed in an attachment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Cornwell whose telephone number is 703-305-6955. The examiner can normally be reached on M-F 6-4 (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

BIC
September 2, 2003


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600